

### **Remarks**

The present application includes claims 1, 4, and 8-10. Claims 1-5 and 7-20 have been rejected by the Examiner. By this Response, claims 1, 4, 8, and 10 have been amended. Claims 2-3, 5-7, and 11-20 are cancelled.

### **Claim Amendments**

Independent claim 1 has been amended to recite that the game feature includes a series of bonus games, each bonus game having a plurality of possible outcomes. The gaming machine includes a selector that enables the player to, prior to the play of the series of bonus games, make a prediction as to a number of times a particular outcome will occur over the combined play of the series of bonus games. If the number of times the particular outcome occurs over the combined play of the bonus games is equal to or greater than the prediction made by the player, the game controller awards a bonus to the player. The value of the bonus awarded to the player is directly proportional to the probability of the number of occurrences of the particular outcome over the combined play of the series of bonus games being equal to or greater than the number of occurrences of the particular outcome as predicted by the player.

The Applicant submits that amended independent claim 1 and its dependent claims 4 and 8-10 should be allowable over the cited art of record.

### **Claim Objections**

The Examiner objected to claims 1, 3-4, 11, and 13-14 because of the following informalities (quoting from the office action):

In claim 1, line 6, the claimed limitation "a base game" should be corrected to "the base game".

In claim 3, line 2, the claimed limitation "the number of times" should be corrected to "a number of times".

In claim 4, line 2, the claimed limitation "the number of times" should be corrected to "a number of times".

In claim 11, line 7, the claimed limitation "a base game" should be corrected to "the base game".

In claim 13, line 2, the claimed limitation "the number of times" should be corrected to "a number of times".

In claim 14, line 2, the claimed limitation "the number of times" should be corrected to "a number of times".

By this response, claims 3, 11, and 13-14 have been cancelled, rendering these objections moot. Additionally, claim 1 has been amended as indicated by the Examiner to recite "the base game". With respect to claim 4, the limitation "the number of times" refers back to and gets its antecedent basis from "a number of times a particular outcome will occur ...", which is found in independent claim 1, from which claim 4 depends. Thus, the Applicant submits that the limitation "the number of times" recited in claim 4 has proper antecedent basis and does not need to be amended. Rather, claim 4 specifies that the particular outcome includes a particular symbol occurring during the playing of the series of bonus games.

Thus, the Applicant submits that the Examiner's objections should be withdrawn.

### **Claim Rejections**

Claim 8 has been rejected under 35 USC 112, first paragraph, as failing to disclose the limitation that “displaying a count of the number of times a particular event has occurred during the base game.” While the Applicant respectfully submits that such a limitation is in fact supported, the Applicant has amended claim 8 to reflect that the display includes a meter for displaying a count of the number of times a particular event has occurred during the series of bonus games. The Applicant submits that the specification does support this limitation with respect to the bonus games and requests that the Examiner’s rejection to claim 8 be withdrawn.

Claims 1-5 and 7-20 have been rejected under 35 U.S.C. 103(a) as being unpatentable over Vancura (U.S. Pat. No. 6,988,732) in view of Brossard et al. (U.S. Pat. No. 6,364,767). The Applicant respectfully traverses this rejection for at least the reasons discussed below.

In Brossard, the player is faced with the choice of “which of these components will occur in the single bonus game to follow?” Two inherent factors of this choice are that: 1) the component selected by the player may not occur at all, and, if it does not occur, no prize will be awarded, and 2) since the player is only provided with a single bonus game, the prediction made by the player has only one “chance” of being correct. While Brossard does discuss the possibility of a second bonus game, if a second bonus game is played, the player must *re-select* components.

In contrast, the pending claims recite a player selecting to predict the *number of times* a certain event will occur over a number of bonus games involved in a feature.

This is a very different choice from predicting a single event in that the player is not able to predict the event itself, only the number of times a particular event will occur in the series of bonus games. Additionally, the player is provided with multiple games over which the prediction may be realized. The player is able to base his or her prediction on considerations of risk versus reward - i.e. the player can predict a low number of occurrences of the event in the series of bonus games (which is more probable but carries a lesser award) or the player can prediction a greater number of occurrences of the event in the series of bonus game (with less probability but greater potential award).

The combined differences in these choices recited in pending claim 1 provide for a very different type of bonus game and player mindset than that disclosed in Vancura and Brossard. Instead of being given a choice of whether a symbol will occur or not (as is essentially provided in Brossard), the player is given the choice of whether he or she would like to predict a low number of symbol occurrences over the next  $X$  games (and be more likely to win a smaller prize) or to predict a high number of symbol occurrences over the next  $X$  games (and be less likely to win a larger prize). Thus, Brossard and Vancura, in combination or otherwise, provide a user with an opportunity to predict what an event will be, as opposed to a number of occurrences of a particular event over a series of games. The nature of the choice provided to the player and, consequently, the nature of the prediction made are distinct.

For at least these reasons, the Applicant respectfully submits that independent claim 1, as amended, should be allowable over the cited art of record.

Similarly, the Applicant submits that claims 4 and 8-10, which depend from claim 1, should also be allowable over the cited art of record for at least the reasons described above.

For example, claim 4, as amended, recites that the outcome the player selects is the number of times a particular symbol occurs during the playing of the series of bonus games. Although the Examiner has rejected this limitation on the basis that it “would have been both well known and obvious design choice according to a designer’s preference”, the Applicant respectfully disagrees. As noted above, the prediction of the number of times a particular symbol will occur over a number of games is a fundamentally different prediction to the prediction of which symbol will occur during one game. The former choice, which *inter alia* provides the player with the ability to make a selection based on risk versus reward, is not taught or suggested in either Brossard or Vancura, and would not have been obvious in light of those references.

This can be seen in attempting to modify Brossard or Vancura to include these limitations which, even with the benefit of the hindsight the present invention provides, would either result in a non-sensical outcome or require fundamental changes to the nature of the games taught in those citations.

For example, in Vancura, the bonus game requires a player to select answers to questions. To modify Vancura such that the player selects the number of times a particular outcome occurs, the player would need to be provided with an answer and made to predict how many of the next  $X$  questions will that answer be the correct answer for (prior, of course, to seeing the questions). Not only would such a scenario provide a non-functioning game and gaming system, it is clearly contrary to the object of Vancura

which is intended to provide enjoyment to a player by providing a bonus game in which a player can select a right answer without making a prediction at all.

Similarly, in Brossard, the bonus game requires a player to select a component from a choice of components - e.g. a particular song title out of four possible song titles. To modify Brossard such that the player selects the number of times a particular outcome occurs, the player would need to be provided with the song title and required to predict how many times that song title will occur in the bonus game. Given that the bonus game of Brossard is a single wheel spin (or, at best, multiple wheel spins with each spin accompanied by a new prediction), this is also non-sensical and non-functioning.

A further feature of difference between both Vancura and Brossard and the pending claims is that the prediction made in the currently pending claims remains the same for the entire series of bonus games (i.e. the player picks one or more symbols prior to the bonus games and does not change that selection thereafter). Vancura discloses a series of questions (bonus games); however, clearly each question requires the player to select a new answer. Were this not the case, a player would select an answer prior to the first question and have that answer apply to all subsequent questions, which would clearly not have been envisioned by the Vancura inventors. Brossard also discloses that a bonus round may involve two or more spins/chances, but discloses that, in this case, the player is returned to the selection process to change his or her selection for the next bonus spin (column 5, line 1).

Thus, for at least these reasons, the Applicant respectfully submits that claims 1, 4, and 8-10 should be allowable.

### **Official Notice**

In the present action, the Examiner has asserted that requiring a player to predict a number of times a particular symbol occurs during the playing of a series of games would have been both well known and an obvious design choice according to a designer's preference. The Examiner has also asserted that displaying a particular information on a display would have been an obvious matter of design choice. As discussed above, the Applicant submits that neither of these limitations as applied to the pending claims constitutes a well know or obvious design choice. If the Examiner is attempting to take Official Notice through her assertion that these limitations are well known, the Applicant respectfully traverses those assertions.

As discussed further below, if the Examiner is asserting that the particular system claimed in the present application are either inherent or well known (i.e., taking official notice), then the Examiner is asked to provide further evidence to which the Applicant can respond. As it now stands, such evidence appears to be lacking.

If the Examiner's assertions are based on the personal knowledge of the Examiner, then under MPEP § 2144.03(C) and 37 C.F.R. § 1.104(d)(2), the Examiner's assertions must be supported by an affidavit from the Examiner. According to MPEP § 2144.03(A), Official Notice, without supporting references, should only be asserted when the subjects asserted to be common knowledge are "capable of instant and unquestionable demonstration as being well-known." That is, the subjects asserted must be of "notorious character" under MPEP § 2144.03(A).

However, the Applicant respectfully submits that the subject matter of the Examiner's assertion of Official Notice is not well-known in the art as evidenced by the

searched and cited prior art. The Applicant respectfully submits that the Examiner has performed “a thorough search of the prior art,” as part of the Examiner’s obligation in examining the present application under MPEP § 904.02. Additionally, the Applicant respectfully submits that the Examiner’s searched and cited references found during the Examiner’s thorough and detailed search of the prior art are indicative of the knowledge commonly held in the art. However, in the Examiner’s thorough and detailed search of the relevant prior art, none of the prior art taught or suggested the subject matter of the Examiner’s assertion of Official Notice. That is, the Examiner’s thorough and detailed search of the prior art has failed to yield any mention of the teachings that the Examiner is asserting as widely known in the art. The Applicant respectfully submits that if the subject matter of the Examiner’s assertion of Official Notice had been of “notorious character” and “capable of instant and unquestionable demonstration as being well-known” under MPEP § 2144.03(A), then the subject matter would have appeared to the Examiner during the Examiner’s thorough and detailed search of the prior art.

If the Examiner had found any teaching of relevant subject matter, the Examiner would have been obligated to list the references teaching the relevant subject matter and make a rejection. Consequently, the Applicant respectfully submits that the prior art does not teach the subject matter of the Examiner’s assertion of Official Notice and respectfully traverses the Examiner’s assertion of Official Notice.

As stated above, the Applicant respectfully traverses the Examiner’s assertions of Official Notice and submits that the subject matter is not of such “notorious character” that it is “capable of instant and unquestionable demonstration as being well-known.” Under MPEP 2144.03, the Examiner is now obligated to provide a reference(s) in support



of the assertion of Official Notice if the Examiner intends to maintain any rejection based on the assertion of Official Notice. Additionally, the Applicant respectfully requests the Examiner reconsider the assertion of Official Notice and provide to Applicant any basis for the Examiner's assertion of Official Notice. None of the cited references provide all of the teachings alleged as well known and necessary by the Examiner. The Applicant respectfully submits that these limitations establish a new way of game play, determination of success, and awarding of a prize. If the Examiner has any questions, the Examiner is invited and encouraged to contact the Applicant at the number below for further discussion.

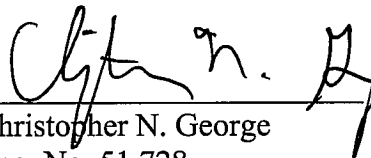
### CONCLUSION

It is submitted that the present application is in condition for allowance and a Notice of Allowability is respectfully solicited. If the Examiner has any questions or the Applicant can be of any assistance, the Examiner is invited and encouraged to contact the Applicant at the number below.

The Commissioner is authorized to charge any additional fees or credit overpayment to the Deposit Account of MHM, Account No. 13-0017.

Respectfully submitted,

Date: August 15, 2007

  
\_\_\_\_\_  
Christopher N. George  
Reg. No. 51,728

McAndrews, Held & Malloy, Ltd.  
500 W. Madison Street  
34<sup>th</sup> Floor  
Chicago, IL 60661  
Phone (312) 775-8000  
Fax (312) 775-8100